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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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appeal
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In re Application of:
Hans-Jurgen Schaschke

Serial No. 09/764974

Filing Date: January 18, 2001

For: ROLLER WITH INK-
REPELLENT COATING

Group Art Unit: 3726

Examiner: Marc Quemuel Jimenez

Commissioner for Patents
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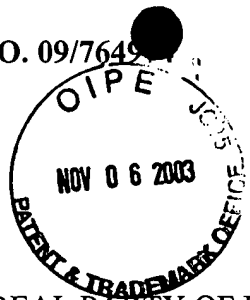


TABLE OF CONTENTS

Page

I. THE REAL PARTY OF INTEREST	1
II. RELATED APPEALS AND INTERFERENCES.....	1
III. THE STATUS OF THE CLAIMS.....	1
IV. STATUS OF AMENDMENTS AFTER FINAL.....	1
V. SUMMARY OF THE INVENTION.....	2
VI. REFERENCE APPLIED AGAINST THE CLAIMS.....	2
VII. THE REJECTION APPEALED FROM.....	2
VIII. THE ISSUES ON APPEAL.....	2
IX. GROUPING OF THE CLAIMS.....	3
X. ARGUMENTS.....	3
A. Group I.....	3
ISSUE 1:	3
ISSUE 2:	3
ISSUE 3:	4
ISSUE 4:	4
ISSUE 5:	4
ISSUE 6:	5
ISSUE 7:	12
B. Group II.....	13
ISSUE 8:	13
C. Group III	13
ISSUE 9:	13
XI. CONCLUSION.....	13
APPENDIX I	i

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APPEAL BRIEF

I. THE REAL PARTY OF INTEREST

Paul Sauer GmbH & Co. Walzenfabrik KG is the real party of interest. The application was assigned and recorded on October 20, 2003 on Reel No. 014057 and Frame No. 0464.

II. RELATED APPEALS AND INTERFERENCES

The undersigned is not aware of any related appeals or interferences involving this application.

III. THE STATUS OF THE CLAIMS

Claims 1-29 have been cancelled. Claim 30 has been withdrawn. Claims 31-41 are pending. The subject of the appeal are claims 31-41 which are attached in Appendix I.

IV. STATUS OF AMENDMENTS AFTER FINAL

There were no Amendments After Final filed. However, the applicants filed a Request For Reconsideration, which was entered pursuant to the Advisory Action mailed September 10, 2003.

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V. SUMMARY OF THE INVENTION

The invention is drawn to a method of using a roller comprising a roller core and a roller covering being composed of an elastomer material containing fluorinated polyolefin or elastic plastic material containing fluorinated polyolefin comprising the step of running the roller in a dampening system of an offset printing machine. The object of the applicants' claimed invention was to lengthen the cleaning intervals, especially of the dampening rollers, while the high quality of the dampening process itself is retained, and to reduce the cleaning costs considerably that way. See the specification at page 3, lines 17-24.

VI. REFERENCE APPLIED AGAINST THE CLAIMS

Arlid *et al.* U.S. Patent No. 3,898,929 ("Arlid")

Meltz U.S. Patent No. 3,345,942 ("Meltz")

VII. THE REJECTION APPEALED FROM

Claims 31-41 were rejected under 35 U.S.C. 103(a) as being unpatentable over Arlid in view of Meltz.

VIII. THE ISSUES ON APPEAL

1. Whether claims 31-41 are rejectable under 35 U.S.C. 103(a) as being unpatentable over Arlid in view of Meltz?
2. Whether Arlid discloses that his rollers that are used in the ink train of a printing press would be the same rollers used in a dampening system?
3. Whether the rollers disclosed by Meltz are used in a dampening system?
4. Whether the Examiner has considered the prior art as a whole?
5. Whether the Examiner's rejection is based on hindsight reconstruction?
6. Whether the Examiner's Statements in the final Office Action are correct?

7. Whether the applicants have established unexpected superior results in their specification for their claimed invention?
8. Whether the Examiner has shown where the prior art teaches the features of the dependent claims (Group II)?
9. Whether the Examiner has shown where the prior art teaches the features of the dependent claims (Group III)?

IX. GROUPING OF THE CLAIMS

Claims 31-41 have been grouped together by the Examiner. These claims do not fall together because of varying degrees of specificity in the claims.

Group I hereinafter refers to claims 31-39.

Group II hereinafter refers to claim 40.

Group III hereinafter refers to claim 41.

Again, these claims do not stand or fall together.

X. ARGUMENTS

A. Group I

ISSUE 1: Whether claims 31-41 are rejectable under 35 U.S.C. 103(a) as being unpatentable over Arlid in view of Meltz?

ISSUE 2: Whether Arlid discloses that his rollers that are used in the ink train of a printing press would be the same rollers used in a dampening system?

Claims 31-41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Arlid in view of Meltz. Arlid discloses a hickey picking cylinder 10 comprising a steel roller core 11 and a roller covering 12 of a rubber latex composition. This is not running in a dampening system but in the ink train of a printing press (abstract; fig. 3; col. 3, lines 7-10 and 33-39). The only place that the dampening system is mentioned is at col. 4, lines 3-10 which Arlid states:

The press is also provided with a dampening system and the fountain solution is transferred from the tray 33 to the coated roller 34 by a roller 35 which is immersed in the solution. The ductor roller 36 oscillates between the two coated rollers 34 and 37 and roller 37 supplies the dampening solution to the hard surfaced rollers 38 and 39 which are in contact with the plate cylinder 19.

The coated rollers 34 and 37 mentioned in connection with the dampening system, however, are not further described. There is no teaching of the applicants' claimed method, let alone the applicants' claimed cover for the dampening roller.

ISSUE 3: Whether the rollers disclosed by Meltz are used in a dampening system?

The roller disclosed by Meltz has a covering comprising rubber having polytetrafluoroethylene particles dispersed therein used in an inking system (col. 5, lines 9-11; claim 5). The teachings of Arlid and Meltz neither alone nor in combination render the claimed invention (comprising the step of running an elastomer or elastic plastic covered roller in a dampening system) obvious. This teaching, however, is totally contrary to the observation underlying applicants' invention. Applicants surprisingly discovered that on the surface of a roller comprising a covering composed of an elastomer material or elastic plastic material containing fluorinated polyolefin which is run in the dampening system of an offset printing machine the ink deposit on the surface of such roller covering is even less than on a roller covering which does not contain the fluorinated polyolefin.

ISSUE 4: Whether the Examiner has considered the prior art as a whole? ISSUE 5: Whether the Examiner's rejection is based on hindsight reconstruction?

The Examiner must consider the references as a whole, In re Yates, 211 USPQ 1149 (CCPA 1981). The Examiner cannot selectively pick and choose from the disclosed

multitude of parameters without any direction as to the particular one selection of the reference without proper motivation. The mere fact that the prior art may be modified to reflect features of the claimed invention does not make modification, and hence claimed invention, obvious unless desirability of such modification is suggested by the prior art (In re Baird, 29 USPQ 2d 1550 (CAFC 1994) and In re Fritch, 23 USPQ 2nd. 1780 (Fed. Cir. 1992)). The applicants disagree with the Examiner why one skilled in the art with the knowledge of the references would selectively modify the references in order to arrive at the applicants' claimed invention. The Examiner's argument is clearly based on hindsight reconstruction.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion, or incentive supporting this combination, although it may have been obvious to try various combinations of teachings of the prior art references to achieve the applicant's claimed invention, such evidence does not establish prima facie case of obviousness (In re Geiger, 2 USPQ 2d. 1276 (Fed. Cir. 1987)). There would be no reason for one skilled in the art to combine Arlid with Meltz. For the above reasons, this rejection should be withdrawn.

**ISSUE 6: Whether the Examiner's Statements in the Final Office
Action are correct?**

The Examiner's rejection is based on the following arguments which are respectfully traversed:

Statement on page 2 of the Final Office Action mailed June 24, 2003 (“Final Office Action”):

“Arlid et al. teach a method of using a roller (fig. 2) comprising a roller core 11 and a roller covering 12 being composed of an elastomer or elastic plastic material (col. 3, lines 13-18) comprising the step of running the roller (fig. 2) in a dampening system (fig. 3, col. 4, lines 3-10) of an offset printing machine (col. 1, lines 25-30).” (emphasis added).

This statement is wrong for the following reasons:

Figure 2 in Arlid is a cross sectional view taken along the line 2-2 of Figure 1 (column 3, lines 5-6) showing the hickey picker cylinder 10 which is provided with a steel core 11 and a rubbery coating 12 (column 3, lines 11-13). Accordingly, the roller (figure 2) is the hickey picking roller designated with the numeral 10.

Figure 3 is a schematic view of the ink train of a conventional offset printing press (column 3, lines 7-8). Figure 3 shows the inking system with the rollers designated with the numerals 23 through 32 (column 3, line 44 – column 4, line 3) and the roller 18 which is in contact with the hickey picking roller 10 (column 3, lines 51-52). Figure 3 also shows the dampening system with the rollers 34 through 39 (column 4, lines 3-10). **Thus, since the hickey picking roller 10 is in contact with roller 18 which, according to Figure 3 and to the Description, is clearly located in the inking system of the described press, Arlid do not teach “running the roller (figure 2) in a dampening system”.**

Statement on page 2 of the Office Action:

“Arlid et al. teach the invention cited with the exception of the elastomer or elastic plastic material containing fluorinated polyolefin.”

This statement is wrong for the reasons explained above. Again, there is no teaching of the applicants' claimed method, let alone the applicants' claimed cover for a dampening roller provided by Arlid.

Statement on page 2 of the Final Office Action:

“Meltz teaches a roller with a roller covering 14 composed of an elastomer or elastic plastic material containing fluorinated polyolefin [PTFE](col. 3, lines 48-61)”.

Although this statement is correct, the roller with the rubber covering 14 embodying Meltz' invention is the roller designated with the numeral 10 in Figure 1 (column 3, lines 20-27), which will be the last form roller 48 to apply ink to the blanket or plate (column 3, lines 41-44). **Thus, Meltz like Arlid, does not disclose running the specific roller in a dampening system.** Note, that Figure 3 solely shows an inking system.

Statement on page 3 of the Final Office Action:

“Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Arlid et al. with the elastomer or elastic plastic material containing fluorinated polyolefin, in the light of the teachings of Meltz, in order to provide a surface that can be easily ground if damaged, will provide a smooth surface with the desired release properties, and to provide a roller that is easier to clean as suggested by Meltz at col. 5, lines 2-8 and lines 21-25.

According to the aforesaid, providing the invention of Arlid with the rubber covering of Meltz having polytetrafluoroethylene particles dispersed therein, one would

arrive at a hickey picking roller running in the inking system of an offset printing press. Again, both Arlid and Meltz do not disclose the claimed method of running a roller comprising a roller core and a roller covering being composed of an elastomer material or an elastic plastic material containing fluorinated polyolefin in a dampening system of an offset printing machine.

Examiner's Response to Arguments on the Final Office Action

Statement on page 4 of the Final Office Action:

“Applicants’ arguments filed 5/30/03 have been fully considered but they are not persuasive”

This statement is respectfully traversed because the applicants believe that their previous arguments were persuasive. The applicants believe that the applicants’ arguments regarding the surprising advantage of running a roller comprising a roller core and a roller covering being composed of an elastomer material containing fluorinated polyolefin or elastic plastic material containing fluorinated polyolefin in a dampening system of an offset printing machine as well as the unexpected results disclosed in the specification have not been considered.

Statement on page 4 of the Final Office Action:

“it is noted that Meltz suggests using the roller for a dampening system. In col. 1, lines 46-51, Meltz teaches that the roller could be used wherever rubber covered rollers have been used in the past. The rolling of ink onto printing plates is clearly a dampening system (col. 1, line 50) also demonstrated by Arlid et al. (see plate cylinder 19 and coated rollers 37).”

This statement contains several inaccuracies:

When disclosing intended uses of the roller according to his invention Meltz explicitly says: ‘and in the printing industry for the rolling of ink onto printing plates’

(column 1, lines 49-50). **Thus, it is obvious that Meltz clearly excludes rollers in the dampening system of a printing press from his invention.** Furthermore, Meltz explicitly discloses the advantageous use of the roller as a form roller in an inking system for printing (column 1, lines 51-52) where the roller serves the dual function of being a form roller and a hicky roller (column 1, lines 54-56).

According to column 4, lines 3-10, the coated roller 37 in the dampening system of Arlid supplies the dampening solution to the hard surfaced rollers 38 and 39 which are in contact with the plate cylinder 19. Supplying dampening solution and supplying ink to the printing plate are two different functions of rollers located in the dampening system or in the inking system of an offset printing press. **Thus, rolling of ink onto the printing plate is clearly not the primary function of a roller in a dampening system.** (Support for this can be found in John MacPhee, Fundamentals of Lithographic Printing, 1998, pages 4-7, see enclosed).

Conclusion drawn from the aforesaid

Concluding the aforesaid, the claimed invention, a method of using a roller comprising a roller core and a roller covering being composed of an elastomer material or elastic plastic material containing fluorinated polyolefin comprising the step of running the roller in a dampening system of an offset printing machine is neither disclosed or suggested by Arlid or Meltz. **All attempts of the Examiner constructing the claimed invention by selectively picking and combining related and non related details from the disclosure of the prior art and mixing such facts with pure assumptions can not establish a case of obviousness because the basic assumption that Arlid were disclosing an elastomer covered roller in a dampening system is not true.**

Even if Arlid were disclosing an elastomer covered roller running in the dampening system of an offset printing machine, the prior art does not provide any motivation that would cause one skilled in the art to modify such roller in the light of Meltz to specifically arrive at the applicants' claimed invention.

According to Meltz, the roller with the rubber covering having polytetrafluoroethylene particles uniformly dispersed therein is primarily used as a form roller in an inking system where it supplies ink to the printing cylinder and attracts dirt particles and paper fibers at its surface (column 5, lines 9-15). As is known in the art (see enclosed copies of John MacPhee, Fundamentals of Lithographic Printing, 1998, pages 4-7), the thickness of the ink film on the surface of an ink roller is just a few (3-6) microns. In addition, the ink rollers, particularly the form rollers which are directly contacting the plate, must deliver a consistent supply of ink to the plate. Therefore, the (form) roller covering of Meltz must have a good attraction to ink to build up a consistent thin ink film on its surface as it is required in the offset printing process.

As outlined in the specification (U.S. 2001/0051567 A1, page 1, paragraph [0004] (see enclosed copy)), it must be prevented that ink spills back from the printing plate into the dampening system, where it pollutes the fountain solution and deposits on the surface of the dampening rollers with the risk of potentially damaging the coverings. **Therefore, one skilled in the art would not be motivated to take the ink receptive ink form roller covering disclosed by Meltz for making an ink-repellent dampening roller covering.**

Further support for this argument is provided by U.S. Patent No. 3,926,116 (Wildeman) which is already on record. Wildeman discloses a separator roller 18 which removes ink from the form dampener roller and sends this ink back into the ink supply system. To accomplish this purpose, the separator roller 18 is covered with a material 18a that has a high affinity for ink. Particularly, the separator roller 18 has a surface covering 18a made of polytetrafluoroethylene resin, because Wildeman discovered that in an environment where both lithographic printing ink and dampening liquid are present, the Teflon (= PTFE by DuPont) will not accept any dampening liquid on the surface, but instead will immediately become wetted with the ink (column 5, lines 10-14 and 56-64).

One skilled in the art would learn from this teaching that subjected to an environment where both printing ink and dampening liquid are present, the polytetrafluoroethylene particles in the surface of the roller covering disclosed by Meltz

would attract and accumulate ink on the roller surface. As outlined in the specification (page 1, 4th paragraph), however, it must be prevented that ink spills back from the printing plate into the dampening system and deposits on the surface of the dampening rollers. Thus, both Meltz and Wildeman teach away from the applicants' claimed invention. Accordingly, one skilled in the art would rather be deterred than motivated to run a roller such as disclosed by Meltz in the dampening system of an offset printing machine.

Therefore, it was a great surprise to the applicant when he discovered that when running a roller comprising a roller covering being composed of an elastomer or elastic plastic material containing fluorinated polyolefin in the dampening system of an offset printing machine the feed back of ink from the plate into the dampening system was diminished and the deposition of ink onto the surface of this roller was reduced.

"Ease of Cleaning"

To construct a case of obviousness the Examiner points out that Meltz claims ease of clean-up for the roller covering embodying his invention. However, when mentioning the cleaning of the roller, Meltz talks of the periodically removing of the dirt and other particles which could cause hickies or spots from the roller surface, as laid out at column 5, lines 18-25. **Thus, according to Meltz ease of cleaning means ease of removing dirt and paper particles from the surface of a hickey picking roller.**

The problem solved by the claimed invention is different. As cited above, in the course of time, ink that spills back into the dampening system deposits on the surface of the roller coverings. Accordingly, a cleaning of the dampening rollers is performed to remove the deposited ink from the roller coverings. As described in Example 1, due to the slower deposition of ink on the surface of the roller embodying the invention this roller had to be cleaned once in the same period of time when a comparative roller had to be cleaned three times. Cleaning a roller surface from ink is not the same as cleaning a roller surface from hickies. Furthermore, preventing a surface from getting contaminated quickly is different to cleaning a surface easily.

Further, there is no disclosure in the prior art showing or suggesting, that running a roller with a roller covering being composed of an elastomer or elastic plastic material containing fluorinated polyolefin in the dampening system of an offset printing machine would provide the following advantages:

- Preventing ink from spilling back from the printing plate into the dampening system (page 6, lines 20-30 of the specification).
- Causing ink depositing more slowly on the surface of a roller covering comprising the fluorinated polyolefin compared to a roller covering not comprising fluorinated polyolefin (Example 1).
- Markedly lengthen the cleaning intervals while retaining the high quality of the dampening process (page 3, lines 19-22 of the specification).
- Improving the wetting and enabling a drastic reduction of the isopropyl alcohol content in the fountain solution (page 7, lines 4-7 of the specification).

The prior art is teaching away from the applicants' invention claiming a method of using a roller comprising a roller core and a roller covering being composed of an elastomer material containing fluorinated polyolefin or elastic plastic material containing fluorinated polyolefin comprising the step of running the roller in a dampening system of an offset printing machine. For the above reasons, this rejection should be withdrawn.

ISSUE 7: Whether the applicants have established unexpected superior results in their specification for their claimed invention?

Assuming *arguendo* that the Examiner has made a *prima facie* case of obviousness, the applicants have shown unexpected results in the specification in which the applicants produce identical examples with the exception of having the fluorinated polyolefin and a non-fluorinated polymer (see Example 1 and the comparison at page 7 of the specification). As noted, with the comparison, the roller had to be cleaned three times while the same roller with the fluorinated polymer the roller had to be cleaned only once. As discussed in the specification at page 3, lines 19-24, the object was to lengthen the cleaning intervals, especially of the dampening rollers while the high quality of the dampening process itself is retained and to reduce the cleaning costs considerably that way. Surprisingly, this object has been accomplished by adding fluorinated polyolefins to the roller covering.

B. Group II**ISSUE 8: Whether the Examiner has shown where the prior art teaches the features of the dependent claims (Group II)?**

In addition to the arguments presented in Group I above, this Group further requires the feature that said thermoplastic elastomer comprises elasticated polyolefin, styrene block copolymer, copolyester elastomer, thermoplastic polyurethane, or a suitable mixture thereof. The Examiner has relied upon Meltz for the disclosure of the rubber roller. The rubber rollers disclosed are disclosed at col. 4, lines 36-42, such as acrylonitrile-butadiene copolymer used in example 1. The Examiner has not shown where the prior art discloses or teaches this elastomer feature.

C. Group III**ISSUE 9: Whether the Examiner has shown where the prior art teaches the features of the dependent claims (Group III)?**

In addition to the arguments presented in Groups I and II above, this Group further requires the feature that wherein said castable polyurethane system comprises a two-component or multi-component polyurethane system. The Examiner has relied upon Meltz for the disclosure of the rubber roller. The rubber rollers disclosed are disclosed at col. 4, lines 36-42. The Examiner has not shown where the prior art discloses or teaches this claimed polyurethane system feature which comprises a two-component or multi-component polyurethane system as is required by this group.

XI. CONCLUSION

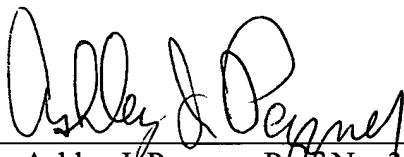
It is believed that the claims define an invention which is new, useful, and unobvious. For the above reasons, the applicants request passage to allowance. This brief is being submitted in triplicate. The PTO is authorized to charge Deposit Account No. 03-2775 the amount of \$165.00. The Notice of Appeal was filed on September 24, 2003. It is believed that no extensions are required.

However, in the event that the undersigned is mistaken in his calculations, an appropriate extension of time to respond is respectfully petitioned for, and the

Commissioner is hereby authorized to charge the account of the undersigned attorneys, Patent Office Deposit Account No. 03-2775, for any fees which may be due upon the filing of this paper.

Respectfully submitted,

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APPENDIX I

30. In an offset printing machine having a damping system wherein the improvement comprises said dampening system comprises a roller comprising a roller core and a roller covering being composed of an elastomer material containing fluorinated polyolefin or elastic plastic material containing fluorinated polyolefin.
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31. A method of using a roller comprising a roller core and a roller covering being composed of an elastomer material containing fluorinated polyolefin or elastic plastic material containing fluorinated polyolefin comprising the step of running the roller in a dampening system of an offset printing machine.
32. The method as claimed in claim 31, wherein said fluorinated polyolefin is selected from fluorocarbon plastics.
33. The method as claimed in claim 31, wherein said fluorinated polyolefin essentially comprises polytetrafluoroethylene or fluorinated ethylene propylene copolymer.
34. The method as claimed in claim 31, wherein said elastomer or elastic plastic material comprises from 0.5 to 25 % by weight of said fluorinated polyolefin.
35. The method as claimed in claim 31, wherein said fluorinated polyolefin is applied as powder or fiber, or in the form of a fibrous material.
36. The method as claimed in claim 31, wherein said roller covering comprises one or more concentric layers and wherein said fluorinated polyolefin containing elastomer or elastic plastic material forms a surface layer of said one or more concentric layers.

37. The method as claimed in claim 31, wherein said elastomer or elastic plastic material is based on natural or synthetic rubber, at least one elastic thermoplastic, at least one thermoplastic elastomer, a castable polyurethane system, or a suitable mixture thereof.
38. The method as claimed in claim 37, wherein said synthetic rubber is selected from acrylonitrile butadiene rubber, ethylene rubber, ethylene-propylene rubber, styrene butadiene rubber, butyl rubber, polyurethane rubber, polyacrylic rubber, epichlorohydrine rubber, silicone rubber, chloroprene rubber, or a suitable mixture thereof.
39. The method as claimed in claim 37, wherein said elastomer or elastic plastic material is based on acrylonitrile butadiene rubber, chloroprene rubber, polyurethane rubber, polyvinyl chloride, or a suitable mixture thereof.
40. The method as claimed in claim 37, wherein said thermoplastic elastomer comprises elastificated polyolefin, styrene block copolymer, copolyester elastomer, thermoplastic polyurethane, or a suitable mixture thereof.
41. The method as claimed in claim 37, wherein said castable polyurethane system comprises a two-component or multi-component polyurethane system.